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IN THE

Supreme Court of the United States

OCTOBER TERM, 1944.

No. 653

AMERICAN-LaFRANCE-FOAMITE CORPORATION,
Petitioner,

vs.

RADCLIFFE M. URQUHART and GEORGE G. URQUHART,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

and

BRIEF IN SUPPORT THEREOF.

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RADCLIFFE M. URQUHART and GEORGE G. URQUHART,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, American-LaFrance-Foamite Corporation, prays that a writ of certiorari issue to review the decision of the United States Court of Appeals for the District of Columbia, filed August 7, 1944 (R. 39), reversing a final decree of the District Court entered July 20, 1943 (R. 31).

A certified transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith, in compliance with Rule 38 of the Rules of this Court.

Summary Statement of the Matter Involved.

Respondents, residents of the Eastern District of Pennsylvania, brought suit against Petitioner, a New York corporation, in the United States District Court for the District of Columbia for alleged infringement of two patents for methods and apparatus for generating and distributing fire-extinguishing foam (R. 1, 2).

Petitioner is engaged in the business of manufacturing and selling at Elmira, New York, fire-extinguishing apparatus, equipment and materials (R. 7).

Jurisdiction was rested on the patent statute. The complaint contained no allegation of Petitioner's corporate organization but charged that it had infringed the patents in suit "at its place of business at 1425 H Street, N. W., Washington, D. C., and elsewhere in the United States by selling" "infringing apparatus and foam generating materials" and "instructing others in using said apparatus and materials" (R. 3). It was not charged with manufacturing or using said goods.

The Marshal's return of service certified only that service was made "by serving W. W. Withers, District Office Manager personally" (R. 4).

Section 48 of the Judicial Code (28 U. S. C. A., §109; Act of March 3, 1897), provides:

> "In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business. If such suit is brought in a district of which the defendant is not an inhabitant,

> but in which such defendant has a regular and established place of business, service of process, summons, or subpoena upon the defendant may be made by service upon the agent or agents engaged in conducting such business in the district in which suit is brought".

This "is the exclusive provision controlling venue in patent infringement proceedings" *Stonite Co.* v. *Melvin-Lloyd Co.*, 315 U. S. 561, 563, 565 (March 9, 1942).

Petitioner moved, in conformity with Rule of Civil Procedure No. 12(b), to dismiss the action and quash the service on the grounds (1) that Petitioner was not subject to service of process within the District of Columbia; (2) that it had not been properly served with process; (3) that the action was in the wrong district because the Petitioner was not an inhabitant of said District, had no regular and established place of business there, and had committed no act of infringement therein (R. 5).

The motion was supported by affidavits of Petitioner's employees, which showed, in brief, that the small office in question bore the Petitioner's name on its door; that name was listed in the Washington telephone directory; the rent was paid by W. W. Withers, Petitioner's sales representative for the District of Columbia and nearby States, and was credited to his account by Petitioner; the office furniture belonged in part to him and in part to Petitioner; no samples were displayed there and there was no stock of goods anywhere in the District. Withers' duties were to solicit business for Petitioner in his territory which extended to North Carolina. He received only commissions. Two salaried employees of Petitioner (affiants Halpin and Ray), had desk room in the office where they carried on their correspondence and did some clerical work. Their regular duties were performed in the Government departments where they were

consulted concerning Petitioner's fire extinguishing products, gave assistance or information concerning them, followed up difficulties arising in their procurement or delivery, and as "contact" men engaged in other similar activities related to Petitioner's business with the Government. A stenographer was employed at said office whose salary was paid by Petitioner (R. 7, 8, 10, 11-13).

The affidavits also showed that all orders for Petitioner's goods whether received directly or through salesmen, were accepted or refused at its Elmira offices; that neither Withers nor the "contact" representatives in Washington ever accepted an order (R. 7, 8), and that no one in said office had any part in billing, shipping or collecting the purchase price for goods sold by Petitioner (R. 8).

These facts were not denied and in the Courts below Respondents claimed they were established and stood upon them.

The same affiants also denied that any acts of infringement of the patents in suit had been committed by Petitioner in the District of Columbia. They stated that none of the materials, apparatus, or equipment described therein had been sold or delivered in the District of Columbia, or shipped by Petitioner to the United States Government, or any of its departments or agencies, or any person, firm or corporation in that District (R. 9, 10, 12, 14). Foam-producing equipment of the general character to which the patents in suit relate is customarily referred to as "air-foam" or "mechanical foam" (R. 25, 26).

Respondents did not attempt to show infringement by *use* or by instructions in the use of the alleged infringing apparatus or processes. Without traversing Petitioner's motion to dismiss, Respondent moved (R. 14) to strike one of Petitioner's aforesaid affidavits and for discovery (by depositions of Petitioner's said affiants) *only* with respect

to the matter of infringement by alleged *sales* or *deliveries* of infringing materials and equipment in the District of Columbia, with particular reference to the Potomac Electric Power Company and the Washington Gaslight Company (R. 15). No discovery was asked for with respect to the Petitioner's alleged place of business in the District.

Respondents' motion was supported by an affidavit of Respondents' counsel, Mr. William A. Strauch, who stated, upon information and belief only, that Petitioner had sold infringing apparatus and "means", identified by the names "PHOMAIRE" and "PHOMAIDE" (trade names of the *maker*, the Pyrene Manufacturing Company, not mentioned in the complaint) to "customer-users" throughout the United States, including the District of Columbia (R. 16); that Respondents had charged the Pyrene Manufacturing Company with infringement; that said Company had no office within the District of Columbia (R. 17); that said Company had brought a declaratory judgment suit against the Respondents in the Eastern District of Pennsylvania (where they reside), "to adjudicate the patents here in suit" (R. 17); and, also on information and belief, that "infringing installations" had been supplied by Petitioner to the two aforesaid public utility corporations within the District of Columbia (R. 17).

In reply to this affidavit, Petitioner's President, Mr. O'Neill, by affidavit specifically denied the sale of the apparatus or "means" mentioned to the utilities named or anyone else in the District of Columbia (R. 18, 19); and Petitioner supported this testimony by affidavits of the appropriate officials of said utilities. Mr. Thielscher (of Potomac Electric Power Co.), stated that his Company had purchased no such apparatus or materials from the Petitioner and (R. 20) did not posses any of the "PHOMAIRE" or

"PHOMAIDE" installations specified by Mr. Strauch. Mr. Leonard stated that while his Company, Washington Gaslight Company, had several of such installations they were not bought or procured from Petitioner (R. 22).

Thereupon Respondents moved for leave to "supplement" their first motion by an affidavit of Respondent R. M. Urquhart (R. 23). He stated that before filing the suit he had information that Petitioner had made sales of infringing apparatus under the names "PHOMAIRE" and "FOAMASTER", in the District of Columbia, and that since the Petitioner's motion he had been "orally advised by an officer of the defendant corporation", not named, that Petitioner had made sales to the Government in the District of Columbia (R. 23, 24).

Petitioner thereupon filed a further affidavit by said O'Neill who stated that *he* had a conversation with Urquhart but did not tell him that Petitioner had ever sold or made contracts for the sale of the alleged infringing goods to the United States Government, or any other person, firm or corporation, in the District of Columbia, but that, on the contrary, he had on several occasions told Mr. Urquhart that all orders received by Petitioner from the Government were accepted or rejected at Petitioner's office in Elmira, and nowhere else (R. 25).

The above described motions were argued together before Chief Justice Eicher of the District Court of the District of Columbia.

Respondents contended in support of their motion that as to alleged or possible acts of *infringement* they were entitled to a *discovery* under Rule of Civil Procedure No. 26(a). Petitioner maintained the contrary and that there was no necessity for the exercise of the Court's discretion under Rule 43(e) to order depositions or an open Court

hearing concerning the place of the alleged infringing acts, that, on the admitted facts and a great weight of authority, said office was *not* a "regular and established place of business" in the District of Columbia; and that Petitioner was not subject to service there and had not been properly served.

Petitioner pointed out that Respondents had not sustained the burden resting on them to show *prima facie* that Petitioner had committed acts of alleged infringement in the District of Columbia. On that question Respondents abandoned the ground upon which they had relied (R. 17) to show infringement, *i.e.* sales to the Washington utility corporations, and without any factual showing asserted that when the defendant received anywhere an order or award from the Government a sale took place in the District of Columbia.

Respondents made no attempt to prove any acts of infringement by Petitioner in that District or to disprove the explicit denial of infringement by sale in the District of Columbia to the Government or any other customer, contained in Petitioner's affidavits (R. 9, 10, 12, 13, 14, 18, 19, 25, 26).

The Trial Court (R. 26), briefly found the facts concerning Petitioner's Washington office and held they brought the case directly within the authority of *Tyler Co.* v. *Ludlow-Saylor Wire Co.*, 236 U. S. 723 (R. 28). He rejected *Shelton* v. *Schwartz*, 131 Fed. (2d) 805 and *James P. Marsh Corp.* v. *U. S. Gauge Co.*, 129 Fed. (2d) 161, upon which Respondents relied, and said it did not seem that the decision of this Court in *Stonite Products Co.* v. *Melvin Lloyd Co.*, 315 U. S. 561, had been called to the Court's attention in *Shelton* v. *Schwartz* (R. 29).

The Court also held (R. 30) that Respondents had failed to sustain the burden of proof resting on them to

show "*prima facie* that defendant corporation had committed acts of infringement in the District of Columbia and that the defendant corporation has a regular and established place of business there within the purview of the statute". Denying Respondents' motion for a discovery, he held that Rule 26(a) would apply only "*after* jurisdiction has been obtained" and that he found "nothing in the rules authorizing discovery in aid of jurisdiction" (R. 30).

A decree dismissing the Bill (R. 31) being entered on July 20, 1943, Respondents filed a petition for reconsideration. It was denied on October 14, 1943, and Respondents appealed to the Court of Appeals for the District of Columbia (R. 32).

That Court filed its opinion on August 7, 1944 (R. 39). Reversing the decree it held:

(1) That the Petitioner had a regular and established place of business in the District of Columbia under Section 48 (R. 40).

(2) That Respondents were entitled to discovery under Rule 26(a) (R. 40).

(3) That the Trial Court did not exercise the discretion conferred upon it by Rule 43(e) as to the taking of depositions (R. 41).

(4) That no reason was disclosed "by the plaintiffs why the suit should be brought in the District of Columbia, an apparently inconvenient forum for both parties", and that the doctrine of *forum non conveniens* might apply (R. 41). Therefore the cause was remanded to the District Court to determine (1) whether it should retain jurisdiction, "applying the principle of *forum non conveniens*" and

(2) in the exercise of the Court's discretion, "whether to take depositions, in the event the first issue is resolved in plaintiffs' favor" (R. 42).

Questions Presented.

The decision of the Court of Appeals of the District of Columbia presents the following questions:

1. Whether Petitioner's said Washington office was a regular and established place of business under §48 of the Judicial Code (U. S. C. A. §109).

2. Whether Petitioner was subject to service of process in the District of Columbia and whether the service made upon it was sufficient.

3. Whether Respondents had sustained the burden of proof resting on them to show *prima facie* that Petitioner had committed in the District of Columbia acts alleged to constitute infringement.

4. Whether Respondents had the right to discovery under Rule 26(a).

5. Whether the District Court exercised its discretion to hear Petitioner's motion on affidavits or wholly or partly on oral testimony or depositions, according to Rule 43(e), and properly so.

A negative answer to Questions 1 or 2 will render unnecessary answers to Questions 3, 4 and 5.

Reasons for Granting The Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds:

1. The decision of the Court of Appeals for the District of Columbia that Petitioner had a regular and established place of business in the District of Columbia under §48 of the Judicial Code is in direct conflict with the decisions of this Court in *Tyler Co.* v. *Ludlow-Saylor Wire Co.,* 236 U. S. 723; *Chicago Car Heating Co.* v. *Gold Car Heating Co.,* 245 U. S. 631; *Anchor Co.* v. *P. & M. Co.,* 258 U. S. 605; with the following decisions of the Circuit Courts of Appeal: *Elevator Supplies Co.* v. *Wagner Mfg. Co.,* 54 Fed. (2d) 939 (C. C. A. 2), affirming without opinion 54 Fed. (2d) 937; *Mas* v. *Nu-Grape Co.,* 62 Fed. (2d) 113 (4th C. C. A.); *Wilson* v. *McKinney,* 59 Fed. (2d) 332; *Endrezze* v. *Dorr,* 97 Fed. (2d) 46; *Phillips* v. *Baker,* 121 Fed. (2d) 752, cert. den. 314 U. S. 688 (all in the 9th C. C. A.); and with numerous decisions of the District Courts, such as *Zimmers* v. *Dodge,* 21 Fed. (2d) 152 (N. D. Ill.); *Haight* v. *Viking Pump Co.,* 29 Fed. Supp. 575 (D. Wis.); *Bowers* v. *Atlantic G. & P. Co.,* 104 Fed. 887 (N. D. N. Y.).

Said decision is also in conflict with several decisions that service of process under the circumstances and in the manner appearing in the case at bar is insufficient to confer jurisdiction, *Green* v. *C. B. & Q. R. R. Co.,* 205 U. S. 530; *Scheuerle* v. *One-Piece Lens Co.,* 241 Fed. 270; *Waterman Co.* v. *Parker Co.,* 100 Fed. 544.

Shelton v. *Schwartz,* 131 Fed. (2d) 805 (C. C. A. 7), relied on by the Court of Appeals, is likewise contrary to the cases above cited and also to *Stonite Co.* v. *Melvin-Lloyd Co.,* 315 U. S. 561.

The Court of Appeals of the District of Columbia has therefore decided a question of general importance and of substance relating to the construction and application of a statute of the United States contrary to the decisions of this and many other Federal Courts and has not given proper effect to applicable decisions of this Court (Supreme Court Rule 38, 5b, c).

2. The Court of Appeals failed to apply to the determination of the question whether plaintiffs had made a *prima facie* showing of defendant's commission of alleged acts of infringement in the District of Columbia, the settled rule that the burden of proof is on the plaintiff to make that showing when jurisdiction is challenged (see R. 30, and also *Phillips* v. *Baker,* 121 Fed. (2d) 752, *Zimmers* v. *Dodge,* 21 Fed. (2d) 152 at 158, and *McNutt* v. *General Motors,* 298 U. S. 178, 189).

3. The holding of the Court of Appeals that Rule 26(a) permits discovery by way of depositions in order to support a jurisdictional allegation is in direct conflict with *Petition of Ferkauf,* 7 Fed. Rule Serv., 537, 540 (S. D. N. Y.) and *Fox* v. *House,* 29 Fed. Supp. 673, 675 (E. D. Okla.).

4. In holding that the District Court did not exercise its discretion in hearing Petitioner's motion on affidavits, as provided in Rule of Civil Procedure 43(e), the Court rendered a decision inconsistent, if not in conflict, with the decision of the Circuit Court of Appeals of the Second Circuit in *Central Mexican Light & Power Co.* v. *Munch,* 116 Fed. (2d) 85, 87 and with two decisions of the Circuit Court of Appeals of the Third Circuit, viz. *Gallup* v. *Caldwell,* 120 Fed. (2d) 90, 93 (Judge Goodrich) and *Victory Co.* v. *Manning,* 128 Fed. (2d) 415.

5. In overruling the District Court's action in hearing Petitioner's motion on affidavits respecting the locus of the defendant's alleged acts of infringement, the Court of Appeals departed from a practice long approved in the Federal Courts in many similar cases of which examples are:

General Electric Co. v. *Best,* 220 Fed. 347;
American Electric Co. v. *Lalance,* 256 Fed. 34;
Campbell v. *U. S. Compressor Co.,* 34 Fed. Supp. 402;

and most of the cases cited under Reason 1 above.

6. Further proceedings as directed by the Court of Appeals will cause delay and expense which is unnecessary. The decision of the District Judge and his construction of the Rules secured the just, speedy and inexpensive determination of the action in conformity with Rule 1.

The questions presented are of much importance and the conflict of decision is one which in the public interest should be settled by the decision of this Court.

WHEREFORE it is respectfully submitted that this petition for a writ of certiorari to the Court of Appeals for the District of Columbia should be granted.

Dated: November 1, 1944.

OSCAR W. JEFFERY,
HARRY G. KIMBALL,
Counsel for Petitioner.

RICHARD K. STEVENS,
Attorney and of Counsel.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Court Below.

The opinion of the United States District Court for the District of Columbia was filed July 15, 1943. It appears at pages 26-31 of the Record. It has not been reported in full. The opinion of the Court of Appeals of the District of Columbia was filed August 7, 1944. It appears at pages 39-42 of the record and is reported in 62 U. S. P. Q. at 328, ~~144 Fed (2d)~~ ~~It has not appeared in the Federal Reporter.~~ 144 Fed.(2d) 542

Jurisdiction.

The jurisdiction of this Court is invoked under Sec. 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The judgment of the Court of Appeals for the District of Columbia which Petitioner seeks to have reviewed, was entered August 7, 1944 (R. 43).

Statement of the Case.

The essential facts of the case are stated in the accompanying petition.

Specification of Errors.

Petitioner will urge, if the writ of certiorari is issued, that the Court of Appeals of the District of Columbia erred in the following respects:

1. In holding that the Petitioner had a regular and established place of business in the District of Columbia within the meaning and intent of Sec. 48 of the Judicial Code. That section appears at page 2 of the accompanying petition.

2. In holding in effect that Petitioner was subject to service of process in the District of Columbia and that the service of the summons was sufficient.

3. In failing to hold that Respondents had not sustained the burden resting upon them to prove the jurisdictional facts.

4. In holding that the Rules of Civil Procedure authorize discovery in aid of jurisdiction.

5. In holding that the District Judge did not exercise his discretion to hear and decide Petitioner's motion upon affidavits, and in assuming the District Judge did not think he had power to direct the taking of depositions under the Rules of Civil Procedure.

Summary of Argument.

The argument will follow the reasons relied upon in the accompanying petition (pp. 10-12).

ARGUMENT.

I.

The decision of the Court of Appeals that Petitioner has a "regular and established place of business" in the District of Columbia within the purview of Sec. 48 of the Judicial Code so that it was subject to service of process there and (in effect) that it was properly served is in direct conflict with the decisions of this and many lower Federal Courts.

Tyler v. *Ludlow-Saylor Co.*, 236 U. S. 723 (1915), the leading case, denied jurisdiction. Its facts corresponded to those in the instant case except that the services of the defendant's sales representative and his office expenses were shared by the defendant with another employer. The Trial Court regarded that office-sharing circumstance to be immaterial, but the Court of Appeals holds that because of it the *Tyler* decision does not apply (R., 40).

This is contrary to two decisions of this Court, *Chicago Car Heating Co.* v. *Gold Car Heating Co.*, 245 U. S. 631 (1917), and *Anchor Co.* v. *P. & M. Co.*, 258 U. S. 605 (1922), where the jurisdictional facts were closely similar to those in the instant case. In those cases the judgments of the District Courts denying jurisdiction were affirmed without opinion upon the authority of *Tyler* v. *Ludlow-Saylor Co.*, but the "office-sharing" circumstance upon which the Court of Appeals now relies to distinguish the *Tyler* decision was absent in both of those cases. It so appears upon examination of the records of the appeals. Clearly it was immaterial in the eyes of this Court that "another corporation shared an agent" with the defendant. More than

a majority of the members of the Court who sat in the two cases above cited also sat in the *Tyler* case.

The Court of Appeals (R., 40) also relies upon *Shelton* v. *Schwartz*, 131 Fed. (2d) 805. The Seventh Circuit Court of Appeals there (p. 808) distinguished the *Tyler* case on the ground that the plaintiff might rely not only upon Sec. 48 of the Judicial Code, but also on Sections 3 and 4 of Subdivision (d) of Rule 4 of the Rules of Civil Procedure providing for service upon managing or general agents, which rule was not in force when the *Tyler* decision was rendered. This was clear error because, first, subdivision (*e*) of Rule 4 directs that whenever a statute of the United States provides for service of a summons, service shall be made in the manner prescribed by the statute, and Sec. 48 specifically prescribes the manner of service in patent infringement suits (see accompanying petition, pp. 2, 3); second, Rule 82 forbids a construction of the rules which "extends or limits the jurisdiction" of the district courts "or the venue of actions therein"; and, third, this Court ruled in *Stonite Co.* v. *Melvin-Lloyd Co.*, 315 U. S. 561, that Section 48 is the *exclusive* provision controlling venue in suits of this character. No other provision can "dovetail" with it (p. 566). This led Chief Justice Eicher to say in his opinion in the District Court that he felt the *Stonite* decision had not been called to the attention of the Court of Appeals of the Seventh Circuit (R., 29).

That Court said also (131 Fed. 2d 809) of the *Tyler* case that there the place of business was a room "rented by another corporation" and the agent was employed by said "other corporation", but the Court did not ground its decision on that circumstance, as does the Court of Appeals here.

That Court's construction of the statutory phrase "regular and established business" is also contrary to numer-

ous decisions of the lower Federal Courts, some of which are cited under "Reason No. 1" in the accompanying Petition (p. 10). Many of them refer to and follow the *Tyler* case but in every one the defendant *alone* employed the sales representative and paid the expenses of the office bearing the defendant's name. Nevertheless it was held in all of them, on facts corresponding closely to those here, that the defendant's office was *not* a "regular and established place of business" within the meaning and intent of Section 48.

Remington Rand v. *Acme Card System Co.*, 71 Fed. (2d) 628 (C. C. A. 4th, 1934) cited by the Court of Appeals, is not to the contrary. The rule of the *Tyler* case was there set forth and approved. The Court sustained jurisdiction because of distinguishing circumstances not present here.

II.

The decision of the Court of Appeals is contrary to the meaning and intent of the statute (Judicial Code, Sec. 48; 28 U. S. C. A., Sec. 109).

That meaning and intent is described and explained in *Bowers* v. *Atl. G. & P. Co.*, 104 Fed. 887; *Cheatham Electric Switch Co.* v. *Transit Co.*, 191 Fed. 727; *Winterbottom* v. *Casey*, 283 Fed. 518, 520; and in *Stonite Products Co.* v. *Melvin-Lloyd Co.*, 315 U. S. 561, where the *Bowers* and *Cheatham* cases are cited as authority. All of these cases hold that this statute is restrictive of jurisdiction in patent infringement suits. Its purpose was to prevent defendants from being attacked in distant districts where defense would be difficult and to resolve confusion and conflict of decision existing prior to the passage of the Act.

III.

The service of process was entirely insufficient.

Sec. 48 of the Judicial Code requires "service upon the agent or agents conducting" a regular and established business of the defendant in the District. There is no showing that Mr. Withers, who was served, was conducting defendant's business in the Washington office. His business was simply to solicit orders "in territory extending as far south of Washington as North Carolina" (R., 10). The Washington office was merely the place where he conducted his correspondence and did his clerical work (R., 10). He did not manage or control the activities of the other two men who used the office for the same purpose but were not sales solicitors and performed their duties wholly in the Government Departments (R., 8, 11, 12). The Court of Appeals was clearly mistaken when it held (R., 40) that they were salesmen who "not only take orders for the defendant's products in the District, but also in neighboring States".

Service on sales representatives or "managers" under circumstances closely similar to those in the instant case is insufficient.

> *Green* v. *C. B. & Q. R. R. Co.*, 205 U. S. 530;
> *Scheuerle* v. *One-Piece Lens Co.*, 241 Fed. 270;
> *Waterman Co.* v. *Parker Co.*, 100 Fed. 544.

IV.

The Court of Appeals did not apply the established rule that the burden of proof was on Respondents to show the jurisdictional facts.

The Trial Court correctly so held, citing authority (R., 30). See also *Phillips* v. *Baker,* 121 Fed. (2d) 752; *Brennan* v. *United Fruit Co.,* 108 Fed. (2d) 710, 711; and *McNutt* v. *General Motors,* 298 U. S. 178, 189.

Respondents completely failed to furnish, or try to furnish, *any* evidence to make out a *prima facie* case of infringement in the District of Columbia, let alone sustain their charge by a preponderance of evidence in accordance with the rule above stated (see pp. 5, 6 of accompanying petition).

V.

Respondents were not entitled to discovery.

Rule 26(a) provides for discovery only "by *leave* of Court *after* jurisdiction has been obtained". The Trial Court found "nothing in the Rules authorizing discovery in aid of jurisdiction" (R., 30). Other Federal Judges have held likewise. *Fox* v. *House,* 29 Fed. Supp. 673, 675 (E. D. Okla., 1939); *Petition of Ferkauf,* 7 Fed. Rule Serv. 537 at 540 (S. D. N. Y.).

The Court of Appeals (R., 40) holds that the Trial Court's interpretation of Rule 26(a) is error, quoting from Moore's Federal Practice a statement of what the author thinks the Court should "ordinarily" do. The statement is not authority for holding the Trial Court in error when

he refused leave as authorized by Rule 26(a) and in so doing "construed" it "to secure the just, speedy and inexpensive determination" of the action, as directed by Rule 1.

VI.

The Court of Appeals erred in holding that the Trial Court "did not exercise its discretion" on Petitioner's motion to dismiss.

In his ruling as to discovery under Rule 26 (R. 30) Chief Justice Eicher did not specifically mention his discretion under that Rule, but it is not to be assumed that he did not exercise his discretion when he decided Petitioner's motion to dismiss on affidavits. It cannot be supposed that he was ignorant of Rule 43(e) and it was repeatedly called to his attention by the parties in briefs, memoranda and oral argument.

In deciding Petitioner's motion to dismiss on affidavits the Trial Judge followed a familiar practice long pursued in many similar motions under Sec. 48. (See *Wilson* v. *McKinney,* 59 Fed. (2d) 332 (9th C. C. A.); *Hoegger* v. *Lawson,* 35 Fed. (2d) 219; *Maw* v. *Northern Pump Co.,* 27 Fed. Supp. 808; *Gibbs* v. *Emerson,* 29 Fed. Supp. 811; and several of the cases cited in the accompanying Petition (pp. 10, 12).

The use of affidavits on preliminary motions has been discussed at length and approved in recent decisions. *Central Mexico Light & Power Co.* v. *Munch,* 116 Fed. (2d) 85, 87 (2d C. C. A. Judge Clark); and *Gallup* v. *Caldwell,* 120 Fed. (2d) 90, 93; *Victory Co.* v. *Manning,* 128 Fed. (2d) 415. (Judge Goodrich, 3d C. C. A.).

VII.

The Trial Court properly exercised his discretion and construed the Rules so as to "secure a just, speedy and inexpensive determination" of the action. (Rule 1).

When the Trial Judge held that Petitioner did not have a regular and established place of business in the District of Columbia, an indispensable element of jurisdiction under Section 48, evidence relating to the locus of acts of alleged infringement became wholly immaterial and unnecessary, and the Court properly relieved the parties from the effort and expense of depositions which were useless.

The Court of Appeals itself holds that the action was brought in an inconvenient forum. The record supports the "belief that the non-resident plaintiffs sought the forum to secure procedural advantages" and the "belief that the matter can be better tried elsewhere" (R. 41), for Respondents alleged gratuitously that one of the patents in suit issued by decree of the District Court of the District of Columbia (R. 3), and asserted by affidavit that they sued Petitioner only after they were unable to find an office of the Pyrene Company, the maker of the alleged infringing goods, in the District. It is evident that Respondents were insistent upon bringing suit in the Court where they would have the advantage of its decision in their favor on the patentability of their invention.

The Pyrene Manufacturing Company has brought a declaratory judgment action to adjudicate the patents in suit in the Eastern District of Pennsylvania where Respondents reside (R. 17) and where the validity and scope of their patents can be determined with much less inconvenience and expense than in Washington. It is therefore

believed, with deep respect for the Court of Appeals, that an inquiry under the doctrine of *forum non conveniens*, with its attendant effort, delay and expense, is unnecessary, and that the Trial Court's disposition of the cause was correct and should be reinstated.

It is urged, therefore, that the petition for a writ of certiorari be granted.

Dated, November 1, 1944.

Respectfully submitted,

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